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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,158	02/09/1999	ZHENGYU YUAN	342312000600	8469

1095 7590 08/05/2003

THOMAS HOXIE
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY
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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 08/05/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/248,158

Applicant(s)

Yuan et al

Examiner

Maurie G. Baker, Ph.D.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 19, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

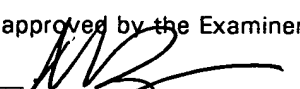
Claim(s) rejected: 1, 3, 5-10, and 19

Claim(s) withdrawn from consideration: 11-18 and 20

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____


MAURIE G. BAKER, PH.D.
PRIMARY EXAMINER
ART UNIT 1639

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

1. Applicant's After Final amendment filed July 19, 2003 raises new issues which would require further search and/or consideration and does not place the case in better form for appeal or in condition for allowance. Thus the amendment will not be entered.
2. Applicant's arguments are moot in view of the non-entry of the amendment. Due to the non-entry of the amendment, all previous rejections are maintained for reasons of record. However, in the interest of compact prosecution, the following is addressed.
3. The After Final amendment proposes to change the language of "can be stimulated" to "is stimulated". While this does set forth the limitation with somewhat more particularity, it still does not fully express the claimed invention as argued.
4. As stated in the Final rejection, there is nothing presently in the claims indicating that "increased scintillation correlates with the progression of the reaction" as argued by applicant. Thus, although it is true that Kasila specifically teaches washing the reaction product away, thus reducing the level of scintillation, it is not clear that the instant claims are specifically limited to a scenario where increased scintillation is measured (correlating with the progression of the reaction). Applicant argues in the After Final amendment that

“increased scintillation is inherent” (page 6). However, note the following with respect to inherency: “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

5. Thus, the examiner maintains that the instant claims are lacking limitations that fully express the claimed invention as argued, even if the proposed amendment is entered.

Moreover, the instant application is subject to an election of species requirement. See MPEP § 803.02 with respect to species elections and After Final amendments (emphasis added):

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.


6. Also, the proposed amendment raises new issues under 35 USC 112, second paragraph as the instant claims do not have the necessary specificity (i.e. do not contain limitations) for the particular reaction, particular surface of the scintillating material and/or particular “molecular property-based binding interaction” and are not limited to scenarios

where increased scintillation correlates with the progression of the reaction. Thus, the proposed change of "can be stimulated" to "is stimulated" would render the claims (dependent claims) indefinite. See paragraph 5 above.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
August 4, 2003



MAURIE GARCIA BAKER PH.D.
PRIMARY EXAMINER